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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,242	05/18/2005	Masuo Koyama	TAD-C560	5781
<div>George A. Loud, Esquire BACON & THOMAS Fourth Floor 625 Slaters Lane Alexandria, VA 22314-1176</div>				
<div>7590 08/17/2009</div>				
<div>EXAMINER CHEVALIER, ALICIA ANN</div>				
<div>ART UNIT PAPER NUMBER 1794</div>				
<div>MAIL DATE DELIVERY MODE 08/17/2009 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,242

Applicant(s)

KOYAMA ET AL.

Examiner

ALICIA CHEVALIER

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Claims 1, 3-7 and 10-15 are pending in the application, claims 2, 8 and 9 have been cancelled in.
2. Amendments to the claims, filed on May 27, 2009, have been entered in the above-identified application.

REJECTIONS

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

4. Claims 1, 3-5, 7, 10, 11, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amimori et al. (U.S. Patent No. 6,559,915) in view of Takahashi et al. (U.S. Patent No. 6,265,133).

Regarding Applicant's claims 1 and 3, Amimori discloses a fingerprint easily erasable/removable film (*col. 31, lines 17-21*). The film (*optical film, title*) has a matted surface represented by an arithmetical mean roughness of 0.05 μm or higher in terms of the arithmetical mean roughness R_a defined in JIS B0601 (*col. 10, line 53 and col. 10, line 63 through col. 11, line 20*). The matted surface further has a ten point mean surface roughness R_z of 0.2 to 2.0 μm (*col. 3, line 60*). The film as a whole has a haze of 1.5 to 35.0% (*col. 10, line 30*).

Amimori fails to disclose that the surface has a wet tension of 25 mN/m or higher.

Takahashi teaches a coating which is fingerprint attachment resistant (*col. 1, lines 11-16*). The coating has a wet tension of 25 mN/m or higher (*col. 9, lines 43-45*). Furthermore, from table 2 it can be seen that if the wet tension is below 20 mN/m (*comparative examples*) the coating does not resist fingerprints.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make Amimori's surface with wet tension of 25 mN/m or higher as disclosed by Takahashi in order to make the Amimori's film resistant to fingerprint stains.

Regarding Applicant's claims 4 and 10, Amimori discloses the film comprises a substrate (*transparent support, figure 2, reference #1, 41*) and a resin layer (*hard coat/low refractive index, figure 2, reference #2, 42 and #3, 43*) provided on the substrate and has the matted surface as a surface of the resin layer (*figure 2*).

Regarding Applicant's claim 5, the limitation "the resin layer is formed from a coating material containing an ionizing radiation curable resin" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Amimori discloses that the resin layer is curable (*col. 28, lines 20-21 and col. 25, lines 52-53*).

Regarding Applicant's claims 7 and 12, Amimori discloses that the resin layer contains silica particles as the matting agent (*col. 16, lines 25-26*).

Regarding Applicant's claims 14 and 15, fails to disclose that the resin of the resin layer has a refractive index of 1.46 to 1.52. However, where in the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges in refractive index involve only routine skill in the art, absence a showing of criticality. MPEP 2144.05 II.

5. Claims 6, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amimori in view of Takahashi as applied above, and further in view of Hasno et al. (U.S. Patent No. 6,716,513).

Amimori and Takahashi are relied upon as described above.

Regarding Applicant's claims 6 and 11, Amimori and Takahashi fail to disclose the resin layer contains two kinds of matting agents having different average particle diameters.

Hasno discloses a coating for optical displays (*col. 4, lines 23-43*). The coating contains two kinds of silica particles having different average particle diameters (*figure 1 and col. 5, lines 45-63*). The coating is antifogging (*col. 4, lines 7-22*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use two kinds of matting agents having different average particle diameters as taught by Hasno in the combination of Amimori and Takahashi in order to impart antifogging.

Regarding Applicant's claim 13, Amimori discloses that the resin layer contains silica particles as the matting agent (*col. 16, lines 25-26*).

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments in the response filed May 27, 2009 regarding the 35 U.S.C. 103(a) rejection over Amimori in view of Takahashi of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Amimori teaches a conventional approach to providing a film surface from which fingerprints may easily be removed. Applicant further argues that fluorocarbon polymers, such as Teflon, are well noted for their very low surface tension.

First, Applicant has not provided any evidence that Amimori's surface tension is "very low" or what constitutes "very low." Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145 I. Second, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that Amimori teach away from using the film in Takahashi because of the "very low" wet tension of the material disclosed in Amimori. Applicant also argues that Takahashi does not teach or suggest any correlation between a high wet tension (surface tension) and ease of removal of fingerprints.

As stated above Applicant has not provided any evidence that the materials used in Amimori have a "very low" wet tension. Also, Applicant has not shown how the use of a higher wet tension material in Amimori would alter the invention of Amimori. Furthermore, even if Takahashi does not suggest any correlation between a high wet tension (surface tension) and ease of removal of fingerprints, the fact remains Takahashi does the having a coating with a wet tension of 25 mN/m or higher which make the coating resistant to fingerprint stains.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/
Primary Examiner, Art Unit 1794
8/14/2009